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PATENT
P57047

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

CHUNG-JEON LEE *et al.*

Serial No.: 10/798,577

Examiner: NGUYEN, TAI V.

Filed: 12 March 2004

Art Unit: 3729

For: METHOD OF MANUFACTURING A BUBBLE-JET TYPE INK-JET
PRINthead
(as amended)

PETITION UNDER 37 CFR §1.144

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions from a finality of a restriction requirement of Paper No.
20051130 mailed 6 December 2006 and finalized on Paper No. 20060215 mailed 23 February 2006.

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I.D.: REB/ML/fw

STATEMENT OF FACTS

1. On 12 March 2004 Applicant filed a divisional patent application (10/798,577) and a preliminary amendment to claim method claims 34-46 as parent 09/798,954 (now USP 6,726,308) was previously restricted to apparatus claims for the device.
2. On 16 December 2005, a Restriction Requirement was mailed (Paper No. 20051130) restricting apparatus claims 34-38 and from method claims 39-46;
3. On 6 January 2006, Applicant filed an amendment and response under 37 C.F.R. 1.143 in response to Paper No. 20051130, provisionally electing the apparatus claims 39-46 while traversing the restriction requirement; and
4. On 23 February 2006, a first Office action on the merits was mailed (Paper No. 20060215) examining only claims drawn to the elected Group II. In Paper No. 20060215, the Examiner finalized the Restriction Requirement of Paper No. 20051130.

REMARKS

The following restriction requirement was imposed in Paper No. 20051130 and finalized in Paper No. 20060215:

- Group I, drawn to a method of manufacturing a bubble jet type ink print head classified in class 29, sub-class 890.1, defined by claims 34-38; and
- Group II, a method of manufacturing a bubble jet type ink jet print head with forming a plurality of resistive heat elements classified in class 29, sub-class 832, and defined by claims 39-46.

The Examiner reasoned in Paper No. 20051130 that these two groups are distinct because invention Group I has separate utility such as depositing and patterning a resistive element.

To begin with, Applicant submits that withdrawn claims 34-38 are drawn to the same exact embodiment as elected claims 43-46. Claims 34-38 and 43-46 are both drawn to a method of making the structure of FIGS. 10-13 as illustrated in FIGS. 15A - 15H. The fact that the Examiner restricted claims 34-38 from 43-46 shows a lack of understanding of Applicant's invention and Applicant's claims on the part of the Examiner. Further, MPEP 806.03 forbids restriction between claims drawn to a single embodiment. Therefore, not only does the present restriction requirement show a lack of appreciation on the part of the Examiner of Applicant's claimed invention, it also

violates U.S. Patent Office practice by violating MPEP 806.03.

Applicant further submits that Applicant previously argued on January 6, 2006 that withdrawn claims 34-38 were drawn to the very same embodiment as elected claims 43-46 and thus should not be restricted as per MPEP 806.03. However, in Paper No. 20060215 where the Examiner finalized the restriction requirement of Paper No. 20051130, the Examiner never responded to or commented on Applicant's argument that the Examiner was attempting to divide apart claims drawn to the same embodiment in violation of MPEP 806.03.

Applicant further submits that this invention was previously restricted in parent 09/798,954 in a communication mailed December 10, 2001 (Paper No. 4). The fact that present divisional 10/798,577 is now being restricted again when it is presently a divisional of an earlier restriction requirement is further evidence of overreaching and abuse on the part of the U.S. Patent Office.

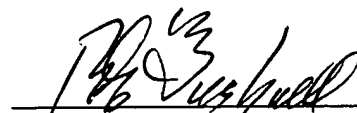
Applicant further submits that after Applicant elected Group II claims 39-46 on January 6, 2006, the Examiner responded in Paper No. 20060215 by saying, "Claims 39-46 have been withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to a nonelected, there being no allowable generic or linking claim." Applicant submits that this statement in Paper No. 20060215 by the Examiner does not reflect Applicant's election of January 6, 2006 and should be corrected or stricken from the record.

RELIEF REQUESTED

Accordingly, the Commissioner is respectfully requested to:

- A. Insist on the withdrawal of the restriction requirement of Paper No. 20051130;
- B. Examine on the merits withdrawn claims 34-38 in the same patent application as elected claims 39-46;
- C. Strike from the record "Claims 39-46 have been withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to a nonelected, there being no allowable generic or linking claim" in Paper No. 20060215; and
- D. Grant such other and further relief as justice may require.

Respectfully submitted,



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